

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

06502.0128-01000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/067,349

Filed

February 7, 2002

First Named Inventor

Gilad BRACHA

Art Unit

2165

Examiner

D. Mizrahi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☐


attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 46,508



Signature

Joseph E. Palys

Typed or printed name

571-203-2713

Telephone number

November 9, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

Attorney Docket No. 06502.0128-01000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Gilad BRACHA et al.) Group Art Unit: 2165
)
Application No.: 10/067,349) Examiner: D. Mizrahi
)
Filed: February 7, 2002)
)
For: METHODS AND APPARATUS FOR) Confirmation No.: 7335
TYPE SAFE, LAZY, USER)
DEFINED CLASS LOADING)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action mailed August 11, 2006. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicants concurrently file the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005.

Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Rejection Under 35 U.S.C. § 101 is Legally Deficient Because the Examiner Twice Failed to Properly Provide Adequate and Detailed Reasons for the Rejection

In the Non-Final Office Action (hereinafter, “NFOA”), the Examiner generally rejected claims 40-95 allegedly under 35 U.S.C. § 101 “because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is ‘useful, tangible and concrete.’” NFOA, page 2. The Examiner further “request[ed] Applicant to include in Applicants claimed limitations (in all the claims) the following: What is the practical application? What is the result? What is the final result that is concrete, useful and tangible?” However, as Applicants pointed out in the Response to the NFOA (hereinafter, “Response”), the Office has the burden to expressly state how the language of the claims has been interpreted to support the rejection. Response, page 21; *See* MPEP § 2106(II)(A). As further noted in the Response, “the claims are of differing scope ... and it is unclear how the rejection applies to the claims.” *Id.* However, in the Final Office Action (hereinafter, “Final OA”), the Examiner substantially repeated the language contained in the NFOA and again failed to properly demonstrate how the claims are rejected under 35 U.S.C. § 101. Final OA, page 3.

This is in direct contradiction with the guidelines set forth in MPEP § 707.07(d), which states “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” Here, independent claims 40 and 50 are directed to methods, independent claims 57, 62, and 72 are directed to systems, and independent claims 79 and 89 are directed to computer-readable storage mediums. The Examiner has twice failed to show how the rejection under 35 U.S.C. § 101 is applicable to those various set of claims.

Furthermore, a rejection under 35 U.S.C. § 101 “should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.” MPEP § 706.03. The Examiner has not done so. Instead, the Examiner “merely presents a conclusion without substantive analysis or evidence to support the position which ... is improper.” *See* Response, page 22. This is further evidenced by the Examiner’s substantial copy of the rejection under 35 U.S.C. § 101 recited in the Final OA, without comment to the merits of Applicants’ remarks presented in the Response.

Therefore, because the Examiner failed to properly clarify the reasons for the rejection under 35 U.S.C. § 101, the rejection is legally deficient and should be withdrawn.

III. The Rejection Under 35 U.S.C. § 101 is Legally Deficient Because the Examiner Improperly Applied the Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

As noted in MPEP § 2106 and repeated in the Response, a claimed process is statutory if it results in a physical transformation for which a practical application is either disclosed in the specification or would have been known to a skilled artisan or is limited to a practical application which produces a useful, tangible, and concrete result. *See* MPEP § 2106. In both the NFOA and Final OA, it is unclear whether the Examiner deems the claims as abstract in nature and requiring a “practical application of an abstract idea” to produce a useful, tangible, and concrete result. *Id.* (citing *State Street*, 149 F.3d at 1373-74, USPQ2d at 1601-02). Indeed, the convoluted nature of the rejection prevents Applicants from ascertaining the true nature of the Examiner’s position in this regard.

Nonetheless, as stated in the Response, Applicants’ claims have practical application and do produce a useful, tangible, and concrete result. For instance, the claims provide a constraint used for ensuring type safe linkage which, as described in Applicants’ specification, provide practical use in an environment that employs multiple runtime name spaces, user defined class loaders, and lazy loading of classes. *See e.g.*, Specification, page 4, line 6 to page 5, line 5. Further, a useful, tangible, and concrete result is produced in that, in one example, a constraint table entry is defined that ensures such type safe linkage. Accordingly, contrary to the Examiner’s assertions, the claims when properly reviewed, recite and identify a practical application having a useful, tangible, and concrete result. The Examiner has not met the burden required to refute this. Accordingly, the rejection under 35 U.S.C. § 101 is legally deficient and should be withdrawn.

IV. The Finality of the Office Action is Improper Because the Examiner Failed to Consider Applicant’s Amendments and Remarks

In the Response, Applicants amended independent claims 40, 57, 79, and 89, and presented arguments as to why the rejection under 35 U.S.C. § 101 was legally deficient. In the Final OA, however, the Examiner stated, “**Applicant’s remarks** (newly submitted amendment with the introduction of new matter) **are considered moot**” (emphasis added). Final OA, page 4. This is improper. MPEP § 707(f) states, “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and

answer the substance of it.” Not only has the Examiner failed to consider Applicant’s Response, but also alleges, without support, explanation, or any guidance, that such arguments are irrelevant. Accordingly, the Final rejection of claims 45-90 is improper and should be withdrawn.

V. The Final Office Action Ambiguously Alleges New Matter Without Definitively Presenting a Rejection Under a Recognized and Pertinent Statute or Rule

Within the 35 U.S.C. § 101 rejection set forth in the Final OA, the Examiner alleges that “Applicant has submitted new matter to the specification.” Final OA, page 4. This position is ambiguous, incorrect, and renders the Office Action legally deficient for at least the following reasons. First, the Examiner has failed to definitively indicate whether the alleged introduction of “new matter” is rejected and/or objected under proper legal grounds. Instead, the Examiner states that “[n]o new matter may be introduced into an application after its filing date.” *Id.* This statement renders the action ambiguous because it fails to adequately present the Examiner’s legal position regarding the specification.

Second, and more significantly, the amendments made to the specification are not new matter because they merely coordinate the summary of the specification with the language of the independent claims. “In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it.” MPEP § 608.04. Here, the amendment to the specification includes the language of independent claims 40, 57, and 79.

Even more confusing is that the same Examiner deems those claims as fully supported by the specification because there is no indication by the Examiner to the contrary. Indeed, there can be none because the claims are fully supported by the specification. Yet, the Examiner now insists the very same claim language presented in the specification is new matter. This contradiction cannot be reconciled. Therefore, not only has the Examiner failed to properly identify the basis for the new matter assertion, but also improperly fails to recognize that the amendments made to the specification do not constitute new matter. Accordingly, the statement that the amendment to the specification adds new matter renders the Final Office Action legally deficient and should be withdrawn.

VI. The Examiner Has Twice Failed to Indicate Complete Examination of the Claims Under 35 U.S.C. §§ 102, 103, and 112

“Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are to be found deficient with respect to some statutory requirement.” MPEP § 2106(II). Even when making a rejection under 35 U.S.C. § 101, “USPTO personnel **must** still examine the claims for compliance with 35 U.S.C. 102, 103, and 112.” See MPEP § 2106(IV)(B) (emphasis added). Here, the Examiner twice rejected the claims citing 35 U.S.C. § 101, and twice failed to indicate examination of the claims and application of prior art under §§ 102 and 103. Therefore, if the Examiner neglected to examine the claims for compliance with 35 U.S.C. §§ 102 and 103, this is improper. Conversely, if the Examiner did in fact examine the claims for compliance under the aforementioned sections, the Examiner then failed to indicate the presence of allowable subject matter, and this too is improper. Accordingly, this renders the Office Action legally deficient, and it should be withdrawn.

VII. Conclusion

In light of the above arguments and those presented in the Request, Applicants submit that the rejections under 35 U.S.C. § 101 are legally deficient and improper. Therefore, the rejection of claims 40-95 should be withdrawn and the claims allowed.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 9, 2006

By: 

Joseph E. Palys
Reg. No. 46,508